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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,909	01/10/2001	Steven W. Arms	1024-035	8315

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EXAMINER

TRINH, MINH N

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,909

Applicant(s)

ARMS ET AL.

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 34-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

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DETAILED ACTION

1. Applicant's election of Group I, species 1A (claims 1-33) in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 34-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group I, there being no allowable generic or linking claim. Election was made in Paper No. 4. In view of finding that the Restriction mailed in or about 4/14/2002, was proper and is correct and further in view of the fact that Applicant has not traversed the Restriction the Restriction is hereby **made FINAL**, Applicant therefore is requested to cancel all non elected claims or take other appropriate action.

An Office Action on the merits of claims 1-33 follows.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Is the recites "a discrete coil" (claim 1, line 1) is same as "a coil"(claim 1, line 2)?

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The phrase: "a conductor wound in a coil" is unclear whether the conductor is the part, which is forming the coil? Further, "wound in" is not positive active method claims. the use of "winding the conductor to form ..." is suggested.

The scope of the claims is not clear because in the claims a second occurring of "comprising "(claim 1, line 3) directed to the outer surface of the coil (claim 1, lines 3-4). Therefore, it is unclear as to whether the applicant relies on the method of fabrication a discrete coil or the outer structure element of the coil.

The phrase: "opening a window" (claim 1, line 4) is unclear in that it is not known what applicants are referring to as "opening a window". Applicants need to be more specific.

Claim 1 set for a fabricating of a coil and in the body of the claims calls for number of steps including "providing a movable core with in the tube"(claim 1, lines 6-7) and it is not clear how these steps are being associated and/or connected to form the with the coil as present in the preamble.

Many terms are vague, indefinite, confusing and/or awkwardly worded, for example, claim 23, lines 2-3, the limitations "... abrading..., or laser ablating said insulation" are vague because it is not clear as to which one of the particular process is used by the claimed process. Also, the phrases: "the step packaging ..." (claim 22, line 1), "said step of opening a plurality of windows" (claim 23, lines 1-2) and many others, lack antecedent bases. Further, applicants should carefully revise the claims to positively recite the manufacturing method steps.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-33 as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Arms et al (US 5,777,467).

Arms et al discloses substantially all limitations of the present invention including: providing a conductor wound in a coil 18 on a tube 15 (see Fig. 2, col. 3, lines 9-40), said coil 18 having a coil outer surface comprising insulation and opening a window in the insulation on the coil outer surface to expose conductor of the coil (see Fig. 2, which shows an opening window at center of the coil 18); and providing a movable core with in said tube for adjusting inductance of said coil (discussed at col. 3, lines 49-50). It is noted that the phrase: " for adjusting inductance..."(claim 1, lines 6-7) is considered to be functionally intended use. And because the applied art meet all the limitations it would be capable of performing the same intended use.

Limitations of claims 2-13 are also met as set forth above.

As applied to claim 11, Arms et al teach an associated housing 11 (see Fig 1). With respect to the cited "for holding..." in claim 11. It is functionally intended use, and the applied art is capable of performing the same intended use.

Limitations of claims 12-22, and 28-32 are also met as set forth above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-33 as best understood, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Arms et al (US 5,777,467) in view of Bernstein (US 4,759,120).

As applied to claim 1, if it is argued that Arms et al do not teach the forming an opening on the outer surface to expose the conductor. Bernstein teaches the forming opening 3-8 (see fig.1A) on the outer surface of the coil to expose the conductor of the coil (col. 3, lines 25-30, col. 4, lines 47-55). It would have been obvious to one having skill in the art to incorporate the teaching of forming an opening to expose part of the conductor of the coil as taught by Bernstein on to the method invention of Arms et al for the benefit of adjusting and connecting purpose as so to simplify the fabricating process.

Limitations of claims 1-22 and 28-32 are also satisfied as set forth above.

As applied to claims 23-28 and 33, Bernstein teaches that the removing insulation materials by means of laser or flame and sanding or etching techniques (see col. 1, lines 45-68). It would have been obvious to one having skill in the art to incorporate forming an opening by means of etching, sanding and/or laser as taught by

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Bernstein on to the method invention of Arms et al efficiency of the operations would result.

Prior Art References

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of method of fabricating a discrete coil device.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



**PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**

mt
June 20, 2002